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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GENENTECH, INC.

Appeal 2009-004239
Application 10/606,745
Technology Center 1600

Decided: August 27, 2009

Before RICHARD E. SCHAFER, RICHARD TORCZON, and MICHAEL P. TIERNEY, *Administrative Patent Judges*.

TORCZON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Genentech requests a rehearing of an earlier decision[1] affirming an examiner's final rejection. The rehearing has been granted, but the requested relief is DENIED.

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[1] *Ex parte Genentech, Inc.*, App. No. 2009-004239 (BPAI 29 May 2009).

MEMORANDUM OPINION

An appellant requesting rehearing of a decision "must state with particularity the points believed to have been misapprehended or overlooked by the Board."[2] Genentech urges that the Board (1) misapprehended the law in basing its decision on 35 U.S.C. 102(g), (2) overlooked Office policy requiring an actual reduction to practice for a rejection under § 102(g), and (3) overlooked the absence of a prior actual reduction to practice.[3]

Interference estoppel

The examiner rejected the claims on appeal using two rationales: (1) interference estoppel combined with 35 U.S.C. 103 and (2) interference estoppel combined with 35 U.S.C. 102(g) and 103.[4] The Board affirmed both rationales.[5] Thus, even if the Board were wrong on the second rationale, the claims would still stand rejected.

Rejection under §§ 102(g) and 103

New argument on rehearing

Genentech argues that an obviousness rejection based on § 102(g) is only possible if the subject matter used as the basis of the rejection was actually reduced to practice.[6] Genentech has not identified where this argument was made in its appeal brief. The Board cannot have overlooked

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[2] 37 C.F.R. § 41.52(a)(1).
[3] Req. Reh'g (29 July 2009) at 1-3.
[4] App. Br. at 6.
[5] Dec'n (29 May 2009) at 11.
[6] Req. Reh'g at 2-3.

or misapprehended an argument that was not made.[7] This procedural omission is also a sufficient basis for denying relief.

Role of the cited examination guidelines

As an initial matter, rejection of the claims using § 102(g) is somewhat ambiguous since there are two distinct parts to § 102(g), the first of which is only available in interferences under 35 U.S.C. 135 or 291.[8] Since the examiner's statement of the rejection and explanation of the rejection firmly based the § 102(g)/§ 103 rejection on the outcome of the interference, the previous decision treated the rejection as arising out of § 102(g)(1) (the interference provision)[9] rather than on § 102(g)(2) (the general provision). In context, the Board's treatment was the only one that comported with the examiner's rationale.

Genentech only directly relies on one authority in its request,[10] an appended document entitled:[11]

> Examination Guidelines for 35 U.S.C. 102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. 102(g) (Revised)

The appended document appears to be a manuscript version of a document published in the Official Gazette of the Patent and Trademark Office.[12] The

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[7] *Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1388 (Fed. Cir. 1989) (observing that prescience is not required of the Trademark Trial and Appeal Board).
[8] 35 U.S.C. 102(g)(1).
[9] See, e.g., Dec'n at 11, explicitly relying on § 102(g)(1).
[10] Req. Reh'g at 2.
[11] *Id.* (original endnote omitted).

quoted portion has been incorporated into the Manual of Patent Examining Procedure.[13] The quoted portion of the guidelines cites two cases. Since guidelines are mainly helpful to the extent they are consistent with the relevant law,[14] it is generally more efficient to address the relevant law directly, using the guidelines mainly to supplement the law at points were the law is unclear or where gaps remain.

Before addressing to the relevant law, however, it is worth observing that the distinction between the two parts of § 102(g) is not mentioned (much less addressed) in the guidelines, which is telling given that the distinction was created in the same Act that prompted the guidelines.[15] Indeed, the guidelines only mentioned interferences twice and then only by way of distinguishing them from what the guidelines address. It is also worth observing that the guidelines are mainly directed to the examining policy for § 102(e), with § 102(g) merely sandwiched in between more extensive discussions of § 102(e). In short, there is no reason to infer that the guidelines even contemplate a rejection based on the result of an interference, much less that they exclude it.

The cited cases

The first cited case is *Kimberly-Clark Corp. v. Johnson & Johnson*,[16] which is cited for the proposition that an obviousness rejection is only

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[12] Dep. Comm'r Pat. Exam., 1266 Official Gaz. (USPTO 14 Jan. 2003).
[13] § 2138 (8th ed. 6th rev., Sept. 2007).
[14] *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 296 F.3d 1316, 1324 (Fed. Cir. 2002); *Ex parte Schwarze*, 151 USPQ 426, 427 (Bd. App. 1966).
[15] Pub. L. 106-113, Sec. 1000(a)(9) [title IV, Sec. 4806] (25 Nov. 1999).
[16] *Kimberly-Clark Corp v. Johnson & Johnson*, 745 F.2d 1437 (Fed. Cir. 1984).

proper if the subject matter was reduced to practice.[17] That is to say, conception without a reduction to practice or with only a constructive reduction to practice does not qualify as having "made" the invention within the meaning of the statute. *Johnson & Johnson* was a case under what would now be considered § 102(g)(2), the general provision, in an invalidity contest based on the in-house laboratory work of the defendant. While the defendant had a patent apparently disclosing the same device, there was no action under § 291 (a patent-patent interference cause of action). Thus, the case does not on its face apply to rejections arising out of an interference.[18]

Moreover, *Johnson & Johnson* is based in part on a policy concern about extending "secret prior art"[19] to situations outside of § 102(e), a concern now moot in view of statutory changes. Genentech has not addressed the effect of the statutory changes to both § 102(g) and to § 103 since 1984, when the case was decided, even though the changes to § 103 were discussed in the previous Board decision.[20] In the years since *Johnson & Johnson*, § 103 has been amended in a way that has been interpreted as making § 102(g) available for obviousness rejections. Congress was plainly not concerned about any "secret prior art" problem. There is no reason to extend the concerns of *Johnson & Johnson* to a rejection based on § 102(g)(1).

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[17] *Id.* at 1444, cited in Req. Reh'g at 3.
[18] The majority opinion in *Johnson & Johnson* never mentions interferences.
[19] *Kimberly-Clark Corp*, 745 F.2d at 1445-46.
[20] Dec'n at 10-11.

The second case, *In re Zletz*[21] is cited for the proposition that in the absence of an actual reduction to practice, a rejection over a patent disclosure (or, the guidelines add, a published application) must be based on § 102(e) rather than on § 102(g). This latter point underscores the fact that the guidelines focus on § 102(e), with § 102(g) being raised mainly for contrast. In any case, this observation citing *Zletz* is not apposite to the rejection in the present case, which has always been based on Genentech's loss in the interference rather than on the disclosure in a patent or published application.

Formal compliance with the examination guidelines

To the extent that Genentech's argument could be understood as a formal challenge to the final rejection, the Board is not in a position to offer relief. Formal noncompliance with the guidelines cannot be a basis for reversing the examiner. The remedy for an examiner's putative failure to follow Office policy is a petition for supervisory review.[22] It is well-established that the Board does not review petitionable matters.[23] On appeal, we must presume that the examiner was acting within the scope of his authority in maintaining a rejection based on 35 U.S.C. 102(g)[24] and focus instead (as we have) on the merits of the rejection.

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[21] *In re Zletz*, 893 F.2d 319, 323 (Fed. Cir. 1989).
[22] 37 C.F.R. § 1.181(a)(3).
[23] *See, e.g., In re Voss*, 557 F.2d 812, 816 (CCPA 1977); *In re Mindick*, 371 F.2d 892, 894 [152 USPQ 566] (CCPA 1967); *accord Meeker v. Merit Sys. Prot. Bd.*, 319 F.3d 1368, 1374 (Fed. Cir. 2003) (rejecting a federal board's assertion of pendent jurisdiction).
[24] *Exxon Corp. v. Phillips Petroleum Co.*, 265 F.3d 1249, 1254 (Fed. Cir. 2001) (holding an Office failure to enforce its rule on interference estoppel

Conclusion

The request does not address the alternate basis for affirmance: interference estoppel. Moreover, the request is improper since it raises a new argument although there was no new ground of rejection. Finally, the request has not demonstrated that the new argument is inconsistent with the previous decision since the authority is readily distinguishable. Consequently, the relief requested is—

DENIED

rvb

cc:

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is not collaterally enforceable); *see generally Carolina Tobacco Co. v. Bureau of Customs & Border Prot.*, 402 F.3d 1345, 1350 (Fed. Cir. 2005) (applying the presumption that a government official has acted properly), *citing United States v. Armstrong*, 517 U.S. 456, 464 (1996) *and United States v. Chem. Found.*, 272 U.S. 1, 14-15 (1926).